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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,622	01/08/2002	Marco Nahmias Nanni	07040.0116	9251

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Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

JOHNSTONE, ADRIENNE C

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,622

Applicant(s)

NANNI ET AL.

Examiner

Adrienne C. Johnstone

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-40, 42-53 and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-35, 43, 44, 47, 48 and 58-60 is/are allowed.
- 6) ☒ Claim(s) 36-40, 42, 45, 46, 49-53 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 031504
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the subject matter of claim 47 is not yet recited in the specification.

One way to overcome this objection would be to amend the specification such that on p.13 line 11 after "glass" is inserted -- , carbon -- .

Claim Objections

2. Claim 37 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The broadest definition in the original disclosure for "substantially constant" dynamic elastic modulus E' over a temperature range between 70°C and 100°C in claim 36 is E' not varying by more than 10% as recited in claim 37, therefore claim 37 does not further limit claim 36.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 36-40, 42, 45, 46, 49-53, and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 36-40, see paragraph 6 above concerning the definition of "substantially constant" dynamic elastic modulus E' . Also, to provide proper antecedent basis, to clarify that it

Art Unit: 1733

is only the uniform thickness underlayer in claims 51 and 52 and not the variable thickness underlayer in claim 53 which has the recited thickness ranges (specification p. 5 lines 10-16), to clarify that the claim 42 ratio is measured using mutually perpendicular directions (specification p. 9 lines 7-14), and to clarify that the claim 36 and claim 57 elastic modulus is in fact the dynamic elastic modulus (E') and that the broadest definition of a "substantially constant" dynamic modulus over a temperature range between 70°C and 100°C in the original disclosure is one which does not vary by more than 10% (specification p. 3 lines 25-27), applicants should make the following amendments to the claims:

rewrite claim 36 as --

36. (currently amended) The tyre of claim 31, wherein the underlayer has [an] a dynamic elastic modulus (E') which [is substantially constant] does not vary by more than 10% over a temperature range between 70°C and 100°C.

-- (specification p. 3 lines 25-27);

cancel claim 37 (now redundant);

claim 38 line 1, change "37" to -- 36 -- ;

claims 38-40 line 1, before "elastic modulus" insert -- dynamic -- ;

claim 42 line 3, change "transverse" to -- perpendicular --;

claim 45 line 2, change "the underlayer comprises a hardening resin based on" to -- the hardening resins are resins based on -- ;

claim 46 line 2, change "the elastomer compound comprises a hardening resin based on" to -- the hardening resins are resins based on -- ;

claims 49 and 50 lines 1-2, change "the elastomer compound comprises" to -- the reinforcing fibers are -- ;

claims 51 and 52 line 2, before "thickness" insert -- uniform -- ;

Art Unit: 1733

claim 53 line 1, change "51" to -- 31 --;

rewrite claim 57 as --

57. (currently amended) The method of claim 58, wherein the thermostable compound has [an] a dynamic elastic modulus (E') which [is substantially constant] does not vary by more than 10% over a temperature range between 70°C and 100°C.

-- .

Allowable Subject Matter

5. Claims 31-35, 43, 44, 47, 48, and 58-60 are allowed.
6. Claims 36-40, 42, 45, 46, 49-53, and 57 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1733

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (571)272-1218.

The examiner can normally be reached on Monday-Friday, 10:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adrienne C. Johnstone
Primary Examiner
Art Unit 1733

Adrienne Johnstone

March 15, 2004

A handwritten signature in cursive script that reads "Adrienne C. Johnstone". The signature is written in dark ink and is positioned to the right of the typed name and title.